

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 4/7/00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **International Lutheran Laymen's League**

Serial No. 75/364,563

Rose N. Perotti of Polster, Lieder, Woodruff & Lucchesi for
applicant.

Laura Gorman Kovalsky, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by International
Lutheran Laymen's League to register the mark THE PUZZLE
CLUB for "printed matter, namely, children's books and
informational flyers featuring a religious message,
bookmarks, folders, stickers, calendars, posters,

contribution envelopes, commemorative prints and instruction manuals for use in local ministry programs."¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles two previously registered marks, both owned by the same entity, as to be likely to cause confusion. The cited marks are THE PUZZLE PLACE and design shown below

("PUZZLE" disclaimed) for "printed matter, namely, book marks, invitations, thank-you notes, paper napkins, banners, door signs, stickers, puzzle books, trick-or-treat bags, activity pads, note pads, calendars, children's books, flash cards, and children's educational newsletters"²

¹ Application Serial No. 75/364,563, filed September 29, 1997, alleging dates of first use of August 19, 1997. Applicant claims ownership of Registration No. 1,800,913 for the mark THE PUZZLE CLUB and design for "jigsaw puzzles."

² Registration No. 2,011,141, issued October 22, 1996. The mark is lined for the colors yellow, blue, pink and green.

and the typed mark THE PUZZLE PLACE ("PUZZLE" disclaimed) for "printed matter, namely, book marks, phone books, money pads, invitations, thank-you notes, paper napkins, banners, door signs, stickers, puzzle books, temporary tattoos, tracing shapes, tracing stencils, trick-or-treat bags, activity pads, note pads, calendars, children's books, flash cards, writing tablets, drawing tablets, and children's educational newsletters, pamphlets and magazines."³

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant contends that inasmuch as the word "puzzle" is disclaimed in the cited registrations, and since the term is suggestive of the theme of applicant's books, more weight should be given to the other portions of the marks when comparing them in the likelihood of confusion analysis. Applicant goes on to argue that "[w]hile the marks THE PUZZLE CLUB and THE PUZZLE PLACE are somewhat similar, they are easily distinguishable in appearance, pronunciation and meaning." (brief, p. 4) With respect to the goods, applicant concedes that children's books,

³ Registration No. 2,019,846, issued November 26, 1996.

bookmarks, stickers and calendars are listed in its application and the cited registration. Applicant contends, however, that the remaining goods are different, and that all of applicant's goods are used specifically in support of local ministry programs. Applicant also states that the goods travel in different channels of trade to different classes of purchasers.

The Examining Attorney maintains that the marks are similarly constructed, both comprising "THE PUZZLE" followed by a one-syllable word having a similar meaning (i.e., a location or area). With respect to the composite mark, the Examining Attorney contends that the literal portion is dominant over the design. As to the goods, the Examining Attorney points out that registrant's identifications of goods are not limited, and that, for example, registrant's children's books are presumed to encompass all types of books, including ones featuring a religious message. The Examining Attorney also points out that applicant's identification of goods does not contain any limitations bearing on channels of trade or classes of purchasers.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion

issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the goods. It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639 (TTAB 1981). The goods need not be identical or even competitive in nature to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way

associated with the same producer or provider. See, e.g., In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, as acknowledged by applicant, children's books, bookmarks, stickers and calendars are listed in both applicant's and registrant's identifications of goods. Further, applicant's goods include posters while registrant's goods include banners. These items would appear to travel in the same channels of trade to the same classes of customers. Most of the remaining items in the respective identifications of goods are specifically different. In sum, given the overlap as to at least a few of the items, confusion is likely to occur if these items were sold under the same or similar marks.

We thus turn to focus our attention on a comparison of applicant's mark THE PUZZLE CLUB and registrant's THE PUZZLE PLACE marks.

The term "PUZZLE" in registrant's marks has been disclaimed. While it is clear that the term is descriptive when applied to registrant's puzzle books, the descriptiveness of the term is not readily apparent viz-a-viz registrant's other goods. Given the puzzle piece design in registrant's composite mark, however, it may well be that the term "PUZZLE" is not an entirely arbitrary term

with respect to the other listed goods. The term "PUZZLE" in applicant's mark clearly is suggestive when applied to its children's books (given the mystery-solving theme thereof), but the term's meaning is less clear with respect to the other products.

Regardless of the exact nature of the term "PUZZLE" in the respective marks, the marks also include different terms, namely, "CLUB" and "PLACE." We think it is a bit of a stretch to state, as the Examining Attorney has done, that "both [terms] share the same meaning, namely, a location or area." (brief, p. 6) Rather, we find that the words, as applied to the goods, have different meanings, and that the marks, in their entireties, convey sufficiently different commercial impressions. The term "place" is defined as "a physical environment; space" while the term "club" means "an association of persons for...the promotion of some common object." *Webster's Third New International Dictionary* (1993). We think that, when the marks are applied to the specific goods of applicant and registrant, these different meanings are the ones most likely to be ascribed to the marks. In sum, applicant's mark THE PUZZLE CLUB and registrant's THE PUZZLE CLUB marks are sufficiently different in sound, appearance and meaning that consumers are not likely to be confused. This is

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especially the case with respect to registrant's composite mark.

Decision: The refusal to register is reversed.

T. J. Quinn

G. D. Hohein

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

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